



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,838	09/10/2003	John F. Gabower	020843-000410US	5171
20350	7590	06/17/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			NGO, HUNG V	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2831	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

82

Office Action Summary	Application No.		Applicant(s)	
	10/659,838		GABOWER, JOHN F.	
	Examiner		Art Unit	
	Hung V. Ngo		2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34, 46 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-34, 51 and 52 is/are allowed.
- 6) ☒ Claim(s) 21, 22, 25, 26, 46, 49 and 50 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 35-45 and 48 were cancelled by Examiner's Amendment on 4/21/2005.

Claims 1-20 and 47 were cancelled by Applicant on 3/21/2005. The claims currently pending are claims 21-34, 46, and 49-52.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 25, 26, 46, 49, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (US 5,519,168).

Owens discloses a shaped polymer substrate comprising a metallized polymer substrate (2)(col. 3, lines 25-40), a conductive material on at least one surface of the shaped polymer substrate (col. 3, lines 35-40),

Re claims 22, 46, the limitations of "reground", "reextruded" have been considered, but does not result in a structural difference. The presence of process limitations in product claims, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to that product. In re Stephens 145 USPQ 656 (CCPA 1965).

Re claim 26, wherein, the conductive material has substantially uniform thickness by using a coating process (col. 3, lines 35-40).

The teaching as discussed above does not disclose the substrate made of a recycled material (re claim 21), the conductive material made of aluminum, copper, or nickel (re claims 25, 49, 50).

Re claim 21, it is well known in the electrical art to use recycled material for being friendly to the environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use recycled material for the polymer substrate for the purpose of being friendly to the environment.

Re claims 25, 49, 50, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use aluminum, copper, or nickel for the conductive material of Owens for intended purpose, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claims 23, 24, 27, 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 29-34, 51, 52 are allowed

Art Unit: 2831

The following is an examiner's statement of reasons for allowance:

The limitation " polyvinyl chloride, polycarbonate, polybutylene terephthalate, or polyethylene terephthalate glycol" of claim 23, the conductive material has a thickness between 1-50 microns" of claims 24, 29, "the substrate has thickness between 0.006 to 0.1 inches" of claim 27, "a plurality of sidewalls" of claim 28 in combination with other limitations present is neither taught nor disclosed in the prior art of record.

Prosecution on the merits of this application is reopened on claims 21, 22, 25, 26, 46, 49, 50 considered unpatentable for the reasons indicated above.

Applicant is advised that the Notice of Allowance mailed 04-21-05 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V Ngo whose telephone number is (571) 272-1979. The examiner can normally be reached on Monday to Thursday 8:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (571) 272-2800 EXT 31. The fax

Art Unit: 2831

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVN
June 10, 2005

 6/10/05
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800